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In re Application of
GRANT et al.
Application No.: 10/538,163
PCT No.: PCT/US03/38900
Int. Filing Date: 08 December 2003
Priority Date: 08 December 2002
Atty Docket No.:IMMR-0152B(34701-000512)
For: HAPTIC MESSAGING IN HANDHELD
COMMUNICATION DEVICES

**DECISION ON REQUEST
UNDER 37 CFR 1.497(d)**

This is a decision on applicants' "Response to Notice to File Missing Parts", treated as a petition to correct inventorship under 37 CFR 1.497(d), and filed on 02 June 2006 in the United States Patent and Trademark Office (USPTO). Petitioner seeks to add Erik J. Shahoian and Dean C. Chang as inventors in the above referenced application. The requisite \$130 petition fee was paid.

BACKGROUND

On 08 June 2005, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371 with, *inter alia*, the requisite basic national fee.

On 30 March 2006, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) & (b), and the surcharge for filing the oath or declaration after the thirty month period, was required.

On 02 June 2006, applicant filed a response to the Notification of Missing Requirements along with an executed declaration. Although the published international application did not identify them as such, the declaration identified Erik J. Shahoian and Dean C. Chang as inventors. Applicant filed a petition for correction of inventorship to add them as inventors. In addition to the \$130 petition fee, Petitioner provided the statements of the inventors Shahoian and Chang in support of the correction of inventorship under 37 CFR 1.497(d).

DISCUSSION

Where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d) names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor that any error in inventorship occurred without deceptive intention on his or her part; (2) the fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee(s).¹

¹37 CFR 1.497(d) states, in part: If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international

Applicants provided statements, signed by Erik J. Shahoian and Dean C. Chang, stating that any error in inventorship in the international application occurred without deceptive intent. These statements satisfy item (1) of 37 CFR 1.497(d). The processing fee of \$130.00 has been paid, satisfying Item (2) above. With regard to Item (3), the written consent of the assignee, Immersion Corporation, consenting to the addition of Erik J. Shahoian and Dean C. Chang as inventors in this application was submitted. Item (3) above is satisfied. Accordingly, applicant has met all of the requirements to add Erik J. Shahoian and Dean C. Chang as co-inventors in the above-identified international application.

However, the declaration appears to be a compilation created from the combination of separately executed declarations. The declaration contains multiple Page 4s. It appears that either the attorney pieced together separate complete declarations into one composite declaration or that the inventors were presented with an incomplete declaration. While it is acceptable for applicants to execute separate copies of the declaration, the entire declaration, as executed by the inventor, must be submitted. "Where individual declarations are executed, they must be submitted as individual declaration rather than combined into one declaration." See MPEP 201.03. The declaration is not properly executed. What is required is one declaration where all inventors have signed or separate complete declarations. The requirements of 37 CFR 1.497 (a) and (b) have not been met and the declaration is unacceptable as filed.

CONCLUSION

For the reasons discussed above, the submission under 37 CFR 1.497(d) to add Erik J. Shahoian and Dean C. Chang as inventors is hereby GRANTED.

As stated above, the declaration submitted on 02 June 2006 is unacceptable as filed. What is required is one declaration where all inventors have signed or separate complete declarations in compliance with 37 CFR 1.497(a) and (b).

Applicant is required to correct the above-noted defects including the furnishing of an oath/declaration in compliance with 1.497(a) and (b) within ONE (1) MONTH from the mail date of this Decision or the time remaining under the 30 March 2006 Notification of Missing Requirements, whichever is longer. No extension of this time limit may be granted under 37 CFR 1.136 but the period for response set forth in the Notification of Missing Requirements may be extended under 37 CFR 1.136(a).

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application, the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor . . . that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(I); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees.

Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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